

-11-

REMARKS

In response to the Final Office Action mailed on August 17, 2005, Applicants respectfully request reconsideration. To further prosecution of this Application, Applicants submit the following remarks. Claims 1-12, 19-30, and 37 - 40 are in allowable condition.

Preliminary Matters

The Examiner stated, in the Response to Arguments" that Applicants argument fails to comply with 37 C.F.R. § 1.111(b) because they amount to a general allegation. Applicants respectfully disagree with the Examiner's characterization of Applicants response.

Rejections under §103

Claims 1-12, 19-30, 37 and 38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Blumenau (U.S. Patent No. 6,505,240, hereinafter "Blumenau").

Blumenau discloses, at column 9, lines 45-59 a method of providing content from a primary site and unsolicited content from a secondary site, via hand off instructions sent after the request for content has been received at the primary content site. The Examiner acknowledges Blumenau has not explicitly disclosed providing the redirection information to the requesting devices. The Examiner also acknowledges Blumenau's system does not initiate content transfer, as content must already be sent to the display site as the instructions are passed with the content.

Therefore, Blumenau fails to teach, disclose or suggest a method of providing content by intercepting, from a requesting device, an initial request for initial content accessible from an initial content source, as recited in Claim 1. In response to intercepting the initial request, Blumenau fails to teach creating redirection information indicating an identity of secondary content to be accessed by the requesting device in addition to the initial content in the initial request, and providing the redirection information to the requesting device, such that the requesting device accesses both the

secondary content from the secondary content source as well as the initial content from the initial content source, as recited in Claim 1.

The Examiner then stated that “it would be a clear extension of his system to further utilize the transferring of handoff information to display sites”. Applicants respectfully disagree with the Examiner’s statement, as it appears the Examiner is using impermissible hindsight afforded by the claimed invention. If the Examiner is to maintain this rejection, he is asked to provide a reference showing the step of creating redirection information indicating an identity of secondary content to be accessed by the requesting device in addition to the initial content in the initial request; and providing the redirection information to the requesting device, such that the requesting device accesses both the secondary content from the secondary content source as well as the initial content from the initial content source.

Therefore, since Blumenau fails to disclose or suggest Claim 1, Claim 1 is believed allowable over Blumenau. Claims 19, 37 and 38 include similar language as Claim 1, and are allowable over Blumenau. Claims 2-12, and 20-30 depend from claims 1, 19, 37 or 38, and are allowable as they depend from a base claim that is allowable.

Claims 13 and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Blumenau in view of Shuster (U.S. Patent No. 6,763,379, hereinafter “Shuster”).

Shuster discloses a monitoring system that monitors user activities, identifies trigger events, measures the elapsed time of inactivity of the user and initiates the presentation of unsolicited data or content to the user computer. Shuster does not disclose a method of providing content by intercepting, from a requesting device, an initial request for initial content accessible from an initial content source. In response to intercepting the initial request, Shuster fails to teach creating redirection information indicating an identity of secondary content to be accessed by the requesting device in addition to the initial content in the initial request, and providing the redirection information to the requesting device, such that the requesting device accesses both the secondary content from the secondary content source as well as the initial content from the initial content source.

The Examiner has therefore attempted to combine Blumenau with Shuster. However, this combination is inappropriate since Blumenau relates to a method of

providing content from a primary and secondary site, via hand off instructions sent after the request for content has been received at the primary content site. Shuster discloses a system for presenting unsolicited data over a wide area network to a user. In order to properly combine references, there must be some basis or extrinsic factor that prompt one of ordinary skill in the art to combine the teachings of the references to arrive at the claimed invention. There is no basis or factor to combine the teachings of Blumenau and Shuster since Blumenau discloses a method of providing content from a primary and secondary site, via hand off instructions sent after the request for content has been received at the primary content site, and Shuster discloses a system for presenting unsolicited data over a wide area network to a user. The Examiner attempted to equate the two by stating that the combination satisfies the need for a content provision system that enables providers to tailor the content being provided in accordance with characteristics of anticipated observers.

In order to properly combine references, there must be some "suggestion of desirability in the combination". In re Noznik, Tatter and Obenauf, 178 USPQ 43, 45 (CCPA 1973); ACS Hospital Systems Inc. v. Montefiore Hospital, 732 F.2d 1572, 1577 (Fed. Cir. 1984). Stated otherwise, there is no intrinsic basis in the prior art or an extrinsic factor that would prompt one of ordinary skill in the art to combine the teachings of Blumenau and Schuster to arrive at the claimed invention. The Examiner's assertion that the combination satisfies the need for a content provision system that enables providers to tailor the content being provided in accordance with characteristics of anticipated observers is only apparent using hindsight provided by the present application. "There must be a reason or suggestion in the art for selecting the procedure used, other than the knowledge of learned from the Applicant's disclosure." *In re Dow Chemical Co.*, 5 U.S.P.Q. 2d 1529, 1532 (Fed. Cir. 1988). Neither Blumenau nor Schuster disclose a manner a method of providing content by intercepting, from a requesting device, an initial request for initial content accessible from an initial content source. In response to intercepting the initial request, Shuster fails to teach creating redirection information indicating an identity of secondary content to be accessed by the requesting device in addition to the initial content in the initial request, and providing the redirection information to the requesting device, such that the requesting device

-14-

accesses both the secondary content from the secondary content source as well as the initial content from the initial content source, therefore it would not have been obvious to combine the references to address a problem which is not disclosed by either reference. There is no reason or suggestion found in the prior art that would have led one of ordinary skill in the art to produce the claimed invention. The Examiner is respectfully requested to withdraw the §103(a) rejection over Blumenau and Schuster.

Even if the combination were made, neither Blumenau or Shuster, taken alone or in combination, disclose or suggest interception of the request, as cited in Claim 1. Blumenau provides content after the request has been received and Shuster presents unsolicited data in response to monitoring activity.

Therefore, Claim 13 is allowable over Shuster. Claim 30 includes similar language as Claim 13, and is allowable over Shuster.

Accordingly, the rejection of Claims 1-13, 19-31, 37 and 38 under 35 U.S.C. 103(a) as being unpatentable over Blumenau in view of Shuster is believed to have been overcome.

The Examiner rejected claims 39 and 40 as being unpatentable over Blumenau in view of Subramaniam. Claims 39 and 40 recite an address of the secondary content, the address of the secondary content representing a location of the secondary content source, a name of the initial content, an address of the initial content, the address of the initial content representing a location of the initial content source, and a delimiter separating the address of the secondary content from the name of the initial content and the address of the initial content, which is not disclosed or suggested by the prior art of record. Claims 39 and 40 depend from claims 1 or 19 and are believed allowable as they depend from a base claim which is believed allowable.

#### Conclusion

In view of the foregoing remarks, this Application should be in condition for allowance. A Notice to this affect is respectfully requested. If the Examiner believes, after this Response, that the Application is not in condition for allowance, the Examiner is respectfully requested to call the Applicant's Representative at the number below.

-15-

Applicants hereby petition for any extension of time that is required to maintain the pendency of this case. If there is a fee occasioned by this response, including an extension fee, that is not covered by an enclosed check, please charge any deficiency to Deposit Account No. 50-3735.

If the enclosed papers or fees are considered incomplete, the Patent Office is respectfully requested to contact the undersigned collect at (508) 616-9660, in Westborough, Massachusetts.

Respectfully submitted,



David W. Rouille, Esq.  
Attorney for Applicant(s)  
Registration No.: 40,150  
Chapin Intellectual Property Law, LLC  
Westborough Office Park  
1700 West Park Drive  
Westborough, Massachusetts 01581  
Telephone: (508) 616-9660  
Facsimile: (508) 616-9661

Attorney Docket No.: CIS01-05(3847)

Dated: April 6, 2006